



UNITED STATES PATENT AND TRADEMARK OFFICE

cm
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,964	03/13/2001	Kazuhisa Kashihara	204702US2	8967

22850 7590 04/18/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

PRASAD, CHANDRIKA

ART UNIT PAPER NUMBER

2839

DATE MAILED: 04/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/803,964

Applicant(s)

KASHIHARA ET AL. 

Examiner

Chandrika Prasad

Art Unit

2839

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Drawings

1. Figures 1A, 1B, 3A, 4 and 5A should be designated by a legend such as -- Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, a slab waveguide in addition to the first and second slab waveguides, and the slab divided into two by intersecting planes must be shown or the feature(s) canceled from claims 3-4. No new matter should be entered. Figure 2 shows the slab 13 divided into two by parallel planes 8, not intersecting planes.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities: P12, line 9 indicates solder 30 to be removed, but there is no indication of a solder to be applied earlier. Page 12, line 11-14 is not clear.

Appropriate correction is required.

4. The following is a quotation of an appropriate paragraph of 37 CFR 1.75:

(d) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See 1.58(a)).

5. Specification is objected under 37 C.F.R. 1.75(d) because the slab divided into two by intersecting planes has not been described in the specification (see claims 3-4)..

Claim Objections

6. Claim 3 is objected to because of the following informalities:

- The claim should end with a period. There are too many periods.
- Line 25: "resion" should be changed to -- region --.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

A slab waveguide in addition to the first and second slab waveguides has been neither described nor shown.

9. Claims 3-4 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to

Art Unit: 2839

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

A slab divided into two by intersecting planes has not been described in the specification or shown in the drawings.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 3-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3: last line of the claim recites "manufacturing method of the metallic film mentioned above", but no method is described in the claim.

12. Claim 3 recites the limitation "the exit end " in line 6 and "the metallic film" in line 33. There is insufficient antecedent basis for these limitations in the claim.

13. Claim 4 recites the limitation "the position shifting member" in line 19 and " the route of the light" in line 17. There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

15. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Yamamoto.

Yamamoto (Claim 1) discloses a method of making a metallic film on a planar substrate comprising the steps of making a mask with holes and manufacturing a metallic film on the substrate through the hole and the use of annealing process.

16. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto.

Yamamoto discloses all the features of this claim except the use of annealing before making the metallic film. Annealing is a well-known process in manufacturing. It would have been obvious to one having ordinary skill in the art at the time of the instant invention to use annealing before forming the metallic film because this would reduce the mechanical stresses in the substrate, which is well known.

19. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art (AAPA) in view of Yamamoto and Booth et al.

AAPA (Figure 4 of the instant invention) shows input waveguides 12 with exit ends connected to a first slab waveguide 13, an arrayed waveguide 14 with a plurality of channel waveguides connected to the exit end of the first slab waveguide, a second slab waveguide 15 connected to the exit end of the arrayed waveguide 14, a plurality of output waveguides 16 connected to the exit end of the second slab waveguide 15. But AAPA does not show any of the slab waveguide divided and the method of making a metallic film. These features are well known in the art of optical connectors. Booth shows a divided waveguide and Yamamoto shows a method of making a metallic film. It would have been obvious to one having ordinary skill in the art at the time of the instant invention to provide a divided waveguide to accommodate separate fibers as shown by Booth, and to make an metallic film by a well known process as taught by Yamamoto as described in Paragraphs 17-18 above.

Art Unit: 2839

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shuto et al. teaches the use of annealing in fiber optics. Matsushima et al. teaches a method of making a metallic film.

Contact Information

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chandrika Prasad at (703) 308-0977.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild, can be reached at (703) 308-2710. The fax number for this Group is (703) 872-9318 (general) and (703) 872-9319 for after-final.

Any inquiry of a general nature or relating to the status of this application or processing should be directed to the Group receptionist whose telephone number is (703) 308-1782.



Chandrika Prasad
Patent examiner
April 15, 2003